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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,116	03/12/2004	Robert J. Cline	26802-37	7068

21130 7590 06/16/2005

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,116

Applicant(s)

CLINE ET AL.

Examiner

Thao T. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/6/04;4/20/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 8-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckwalter et al. (US Pat. 6,586,066).

Buckwalter teaches the underlayment assembly for installing and bonding of surface coverings, such as floor, wall, and ceiling coverings thereto (see col. 4, ln. 1-5). The assembly comprises an underlayment 12, pressure sensitive adhesive layers 18, 18', and release sheets 20, 20' (see Fig. 1-2; col. 4, ln. 1-30). Buckwalter teaches an adhesive layer, comprising a mixture of adhesive polymers, such as asphalt, styrene isoprene styrene, styrene butadiene styrene; a tackifying resin, such as aliphatic or aromatic hydrocarbon; plasticizing oil (see col. 6, ln. 28-54).

Although Buckwalter does not teach the assembly to be an adhesive tape wound into a roll, in the background of the invention, Buckwalter discloses that it has been taught in the prior art that a pressure sensitive adhesive layer disposed on a release layer in self-adhering tile would be wound into roll (see col. 1; ln. 11-28). Thus, it would have been obvious to one of ordinary skill in the art to have employed the adhesive composition of Buckwalter in an adhesive tape that would be wound into a roll as well as long as the adhesive system creates a bond with the flooring material by contact and pressure (see col. 6, ln. 28-30).

Although Buckwalter is silent with respect to the use of the adhesive tape in adhering a mirror or a flat glass to a substrate, the reference teaches the underlayment assembly for installing and bonding of surface coverings, such as floor, wall, and ceiling coverings thereto, by pressuring the assembly to the surface (see col. 4, ln. 1-5; col. 6, ln. 28-30). It would have been obvious to one of ordinary skill in the art to have used the adhesive system in mounting a mirror or a glass onto a substrate as well.

Buckwalter is silent with respect to the specific type of the asphalt. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that asphalt would have been one of the types as recited in the instant claim, such as synthetically manufactured, residual, petroleum, or combination thereof.

With respect to the shape of the adhesive assembly, it has been known within the skill in the art that configurations would have no significant patentable weight.

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckwalter as applied to claims 1 and 9 above, and further in view of Davis et al. (US Pat. 5,859,114).

Buckwalter is as set forth in claims 1 and 9 above and incorporated herein.

Buckwalter does not teach the addition of a filler in the adhesive composition.

Davis teaches an adhesive composition comprising styrene isoprene styrene, styrene butadiene styrene; and a reinforcing filler, such as magnesium silicate (see abstract; col. 13, ln. 13-21). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the reinforcing filler, as taught by Davis, in the adhesive composition of Buckwalter, for the purpose of enhancing the strength and endurance of the adhesive layer.

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4. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckwalter as applied to claim 1 above, and further in view of Joseph et al. (US Pat. 6,107,222).

Buckwalter is as set forth in claim 1 above and incorporated herein.

Buckwalter does not specify the plasticizing oil.

Joseph teaches a pressure sensitive adhesive comprising styrene isoprene styrene, styrene butadiene styrene, a tackifying resin, and a liquid plasticizer, such as naphthenic oils (see col. 5, ln. 46-52). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed naphthenic oil, as taught by Joseph, in the adhesive composition of Buckwalter, because Joseph teaches that naphthenic oil is compatible with the hydrocarbon tackifying resins.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
June 13, 2005

Thao Tran

**THAO T. TRAN
PATENT EXAMINER**